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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,867	07/31/2001	A. Peter Powell	41698-1024	2424

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EXAMINER

GAUTHIER, GERALD

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,867

Applicant(s)

POWELL ET AL.

Examiner

Gerald Gauthier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim(s) Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claim(s) at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claim(s) under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claim(s) was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim(s) that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. **Claim(s) 1-3, 5-13, 15-20, 23-27, 29-36, 38-43, 46 and 47** are rejected under 35 U.S.C. 103(a) as being unpatentable over Corlett et al. (US 5,832,060) in view of Brown et al. (US 5,333,180).

Regarding **claim(s) 1, 8, 25 and 31**, Corlett discloses an apparatus for facilitating communications between a caller and a called party (FIG. 1 and column 1, lines 6-10), the apparatus comprising:

a processor (Detector 20 on FIG. 2A) for determining an unsuccessful communication between the caller and the called party (FIGS. 2A-2B and column 7, lines 5-14);

storage (Receiver 60 on FIG. 2B) for storing a message for the called party provided by the caller after the unsuccessful communication, and data concerning a telephone number in association with the message for contacting the caller (FIGS. 2A-2B and column 7, lines 14-33) [The receiver 60 stores the message left by the caller 12 and the telephone number associated with the caller 12];

a mechanism interface (Caller 80 on FIG. 2B) for initiating a first connection in accordance with the preference to deliver the message therethrough to the called party, the first connection being established through a communication network (FIGS. 4A-4B and column 10, lines 25-45) [The caller 80 places a first call to the called party 14 based on the information received from the calling party 12, which selects the callback service];

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a device for detecting a signal generated by the called party, which indicates an initiation of a call to the caller (column 13, lines 4-15) [The second player 50 receives indication from the called party 14 for an automatic callback to the caller 12]; and

a second interface (Peripheral 18 on FIG. 1) responsive to the detected signal for retrieving from the storage the data concerning the telephone number stored in association with the message, a second connection to a communication device associated with the telephone number being established based on the retrieve data, the first connection being connected to the second connection through the communication network (column 13, lines 15-29) [The peripheral 18 retrieves the calling party number stores previously on the receiver 60 and places a call to the caller 12 in response to the election of the calling party 14, thereby the first connection being connected to the second connection through the communication network 16].

Corlett discloses prompting the caller to select a callback service but fails to disclose an interface for prompting the caller, after the unsuccessful communication, to provide at least one preference concerning delivery of the message.

However, Brown, in the same field of endeavor, teaches an interface for prompting the caller, after the unsuccessful communication, to provide at least one preference concerning delivery of the message (FIG. 1 and column 8, lines 34-50) [The call message delivery service 120 prompts the caller to customize the delivery instructions of the message left for the recipient].

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It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Corlett using the call message delivery service as taught by Brown.

This modification of the Corlett' s invention would allows an interface for prompting the caller, after the unsuccessful communication, to provide at least one preference concerning delivery of the message so that the caller would choose the appropriate language to deliver the message.

Regarding **claim(s) 2 and 26**, Corlett discloses, the message is recorded by the caller (column 10, lines 25-45).

Regarding **claim(s) 3 and 27**, Corlett discloses, a message identification is assigned to the message for association with the telephone number (column 8, lines 15-27).

Regarding **claim(s) 5, 15, 23, 29, 38 and 46**, Corlett discloses the telephone number is provided by the caller (column 12, lines 37-41).

Regarding **claim(s) 6, 16, 24, 30, 39 and 47**, Corlett discloses the signal includes a DTMF signal (column 12, lines 54-61).

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Regarding **claim(s) 7**, Corlett discloses a voice response unit (column 9, lines 6-20).

Regarding **claim(s) 9 and 32**, Corlett discloses the preference includes a time range within which the message is delivered (column 10, lines 25-45).

Regarding **claim(s) 10 and 33**, Corlett discloses the preference includes a number of attempts to deliver the message and the number of attempts is not greater than a predetermined maximum limit (column 10, lines 25-45).

Regarding **claim(s) 11, 18, 34 and 41**, Corlett discloses the call was unanswered due to a busy condition (column 7, lines 5-14).

Regarding **claim(s) 12, 19, 35 and 42**, Corlett discloses the call was unanswered due to a ring-no-answer condition (column 7, lines 5-14).

Regarding **claim(s) 13, 20, 36 and 43**, Corlett discloses wherein the call was unanswered due to a communication problem (column 7, lines 5-14).

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Regarding **claim(s) 17 and 40**, Corlett in combination with Brown disclose all the limitations of **claim(s) 17 and 40** as stated in **claim(s) 1**'s rejection and furthermore Corlett discloses a server for providing a destination telephone number for contacting the desired party (column 11 lines 4-10).

5. **Claim(s) 4, 14, 21-22, 28, 37, 44 and 45** are rejected under 35 U.S.C. 103(a) as being unpatentable over Corlett in view of Brown as applied to **claim(s) 1, 8, 17, 25, 31 and 40** above, and further in view of Hammond (US 5,155,761).

Regarding **claim(s) 4, 14, 22, 28, 37 and 45**, Corlett in combination with Brown as applied to **claim(s) 1, 8, 17, 25, 31 and 40** differs from **claim(s) 4, 14, 22, 28, 37 and 45**, in that it fails to disclose an automatic number identifier.

However, Hammond teaches the telephone number is derived from an automatic number identifier (column 4, lines 51-56).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the automatic number identifier of Hammond in the invention of Corlett combined with Brown.

The modification of the invention would offer the capability of an automatic number identifier of an automatic callback for certain incoming calls.

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Regarding **claim(s) 21 and 44**, Hammond teaches an operator assisting the customer to obtain the information (column 5, lines 25-40).

Response to Arguments

6. Applicant's arguments with respect to **claim(s) 1-47** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER

g.g.
July 18, 2005


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